

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte OLE K. NILSSEN

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Appeal No. 1997-3995  
Application 07/952,303

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ON BRIEF

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Before THOMAS, JERRY SMITH and LALL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

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Application No. 07/952,303

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, 17-20, 28, 29 and 33-43<sup>1</sup>, which constitute all the claims remaining in the application.

The disclosed invention pertains to a self-oscillating inverter ballast for supplying power to a load such as a fluorescent lamp.

Representative claim 1 is reproduced as follows:

1. An inverter powered from a constant-magnitude DC voltage by way of a first sub-assembly and providing, between a first and a second output terminal, an alternating output voltage having a periodic and substantially sinusoidal waveshape, said waveshape having a cyclical period, said first sub-assembly being operative to cause any current flowing from the DC voltage supply to the inverter to remain substantially constant during the time-length of said cyclical period, said inverter comprising:

a first and a second pair of series-connected switching transistors, each transistor having a control input

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<sup>1</sup> Appellant's claims 30-40 added by amendment on August 29, 1995 were respectively renumbered by the examiner as claims 33-43 pursuant to 37 CFR § 1.126.

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terminal, said first pair of transistors each having a terminal that is connected with a first junction, said second pair of transistors each having a terminal that is connected with a second junction; the first and second junctions being galvanically connected with the first and second output terminals, respectively; and

second sub-assembly connected between said junctions and in circuit with each transistor's control terminal, said second sub-assembly comprising a tuned circuit and a third sub-assembly functional to cause said transistors to switch on and off in a time-pattern operative to cause said output voltage to have said periodic and substantially sinusoidal waveshape.

The examiner relies on the following references:

|         |           |               |
|---------|-----------|---------------|
| Burke   | 4,277,726 | July 07, 1981 |
| Walden  | 4,346,332 | Aug. 24, 1982 |
| Nilssen | 5,189,342 | Feb. 23, 1993 |

The following rejections have been made against the claims:

1. Claims 1-9, 17-20 and 33-43 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Walden in view of Burke.

2. Claims 28 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burke taken alone.

3. Claims 1-9, 17-20, 28, 29 and 33-43 stand rejected under the judicially created doctrine of double patenting over

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claims 1-19 of Nilssen "since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" [answer, page 4]. Although this rejection was designated as a new ground of rejection in the answer, appellant had been responding to a double patenting rejection made on this basis all during the prosecution. Therefore, appellant's failure to

respond to this "new" rejection does not lead to dismissal of the appeal as indicated by the examiner.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in

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rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner has failed to provide us with a record which establishes a prima facie case of obviousness or of double patenting for any of the claims on appeal. Accordingly, we reverse.

We consider first the rejections of the claims under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438

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(Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to independent claims 1, 17, 38 and 42,

the examiner points out certain teachings of Walden and Burke and concludes that "[i]t would have been obvious to person of ordinary skill at the time the invention was made to combine the references of Burke and Walden in the configuration set forth by applicant's invention because Walden switches allow for the convenient switching to drive a discharge lamp and Burke allows the rapid starting of fluorescent lamp system over a first and second time interval thereby facilitating timing and controlling of the oscillator circuit" [final rejection, page 4].

With respect to claim 1, appellant argues that Walden does not generate an output voltage that is periodic and substantially sinusoidal as asserted by the examiner. The examiner does not respond to this argument. Appellant points to additional specific features of claim 1 and asks the examiner to point out how these specific features are rendered obvious by the applied prior art. The examiner does not respond to this argument. Appellant points to the examiner's reasoning in support of obviousness quoted above and argues that the reasoning makes no sense because there is no motivation to combine the teachings of Burke with Moore and

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there is no benefit to be gained as asserted by the examiner. The examiner does not respond to this argument. The examiner simply refers to the final rejection which never responded to these arguments and only addressed a rejection made on references to Burke and Steigerwald but not to the rejection based on Walden and Burke.

It is sufficient to note that the examiner has utterly failed to establish a prima facie case of obviousness. In our view, appellant has raised several legitimate questions regarding the teachings of the applied prior art which have gone unanswered by the examiner. Since the examiner has not addressed the differences asserted by appellant between the invention of claim 1 and the teachings of the applied prior art, the examiner has not met his burden of establishing a prima facie case of obviousness. Therefore, we do not sustain the rejection of claim 1 or of claims 2-9 which depend therefrom. Since independent claim 42 has limitations similar to claim 1, we do not sustain the rejection of claim 42.

With respect to independent claim 17, appellant again points to specific features of the claim and argues that the examiner has not identified any elements in the applied prior



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art which teach or suggest these claim limitations. The examiner again offers no response. Therefore, we do not sustain the rejection of claims 17-20 for the same reasons discussed above.

With respect to independent claim 28, the examiner points out certain teachings of Burke and concludes that "it would have been obvious to a person of ordinary skill at the time the invention was made to have a center [tap] on the input side to filter out any residual frequencies as noted by the use of filtering capacitors (32, 33) of Burke" [final rejection, page 5].

Appellant argues that Burke does not teach the specific features of the DC voltage source. The examiner does not respond to this argument. Appellant addresses the examiner's reasoning behind his conclusion of obviousness and disputes that a center tap would filter out residual frequencies as claimed. The examiner does not respond to this argument. Appellant argues that the claimed arrangement is operative to provide an AC voltage between the inverter output terminal and the center tap and that the examiner has failed to address this feature. The examiner does not respond to

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this argument. Appellant argues that the specific features of the inverter recited in claim 28 have not been addressed by the examiner. The examiner does not respond to this argument.

For the same reasons discussed above, the examiner has failed to establish a prima facie case of obviousness.

Therefore, we do not sustain the rejection of independent claim 28 or of claims 29 and 33-37 which depend therefrom. Since independent claim 38 has limitations similar to the limitations discussed above with respect to other claims, we do not sustain the rejection of independent claim 38 or of claims 39-41 and 43 which depend therefrom.

We now consider the rejection on double patenting. The complete rejection is set forth as follows:

Claims 1-9, 17-20, 28-29 and 33-43 are rejected under the judicially created doctrine of double patenting over claims 1-19 of U. S. Patent No. 5,189,342 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: They are both directed to the same kind of self-oscillatory inverter ballast circuits..

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during the prosecution of the application which matured into a patent. In *re* Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804 [answer, pages 4-5].

Appellant argues that the examiner has offered nothing more than his unsupported assertion that improper double patenting is present here. Appellant points to differences between the claims of the instant application and the claims of the Nilssen patent, and appellant argues that these claimed differences preclude the application of the double patenting rejection. The examiner does not respond to these arguments.

The examiner has termed this rejection as a judicially created rejection which may be overcome by the filing of a terminal disclaimer [answer, page 3]. Accordingly, we view this rejection as being based on the judicially created doctrine of obviousness-type double patenting.

As with all rejections, the examiner has the burden of presenting a prima facie case of unpatentability. In *re* Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In making an obvious double patenting rejection, the examiner

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must demonstrate that each claim of the application is unpatentable over a single claim of a patent. This demonstration should contain a showing of what is recited in each respective claim of the application and the corresponding respective single claim of the patent. An analysis of the differences between these claims should then be provided. Finally, a discussion as to why the artisan would have found it obvious to modify the claim of the patent or to combine the claim with additional prior art teachings to arrive at the application claim must be presented by the examiner. The examiner's demonstration here contains none of these showings. Since the examiner has not made a proper obviousness analysis with respect to each of the appealed claims, we will not sustain the double patenting rejection because the examiner has not met his initial burden of presenting a prima facie case of unpatentability.

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In summary, we have not sustained any of the examiner's rejections in this appeal because the examiner has failed to establish a prima facie case of unpatentability. Therefore, the decision of the examiner rejecting claims 1-9, 17-20, 28, 29 and 33-43 is reversed.

REVERSED

|                             |   |                 |
|-----------------------------|---|-----------------|
| James D. Thomas             | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| Jerry Smith                 | ) |                 |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) |                 |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
| Parshotam S. Lall           | ) |                 |
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JS/dm

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